

Remarks

Claims 1 to 8, 10 to 14, 17 and 18 are currently pending and being considered in the present application. (claims 15 and 16 were previously withdrawn in response to a restriction requirement).

Reconsideration is respectfully requested based on the following.

Claims 1 and 17 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

It is conclusorily asserted that claim 5 is indefinite because it is ambiguous as to whether “outputting useful data in a vehicle refers to system or device is inside the vehicle or the data is inside the vehicle”. *Paper Number 20080215, p. 2*. It is respectfully submitted that the specification discloses the subject matter of claim 5 and its feature of outputting useful data in a vehicle. (See, e.g., page 2, lines 14–29; and page 3, lines 20–31).

It is therefore respectfully requested that the indefiniteness rejections of claims 1 and 17 be withdrawn.

Claims 1 through 14 and 17 to 18 were rejected under 35 U.S.C. § 102(e) as anticipated by Taniguchi et al., U.S. Patent No. 7,212,989 (“Taniguchi”).

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully

submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 1 now includes the features of claim 9, which is cancelled without prejudice. Claims 10 to 13 were rewritten to be consistent with claim 1, as presented.

The Taniguchi reference concerns a vehicle-mounted communication device and a road-to-vehicle communication device which allow communication of information using a simple structure by making leakage of information difficult. Information including encryption information is communicated between an on-road apparatus having a memory in which an electronic key is stored, and a vehicle-mounted apparatus having a storage circuit. Encrypted route information is stored as is in the vehicle-mounted apparatus and encryption/decoding are executed at on on-road apparatus. Accordingly, the vehicle-mounted apparatus does not require encryption or decoding. (See Abstract). However, the lack of encryption/decoding in the vehicle means that encrypted information cannot be “output” i.e. played back on radio, CD, DVD or other media player inside the vehicle.

Accordingly, Taniguchi, does not identically describe (or suggest) the feature of “checking in a rights analysis unit, which is coupled to a playback unit, whether a usage right exists for the useful data to be played back,” as in claims 1 and 17.

In particular, Taniguchi refers to preparation of the toll information and transmission, together with an end signal, to the vehicle mounted apparatus in the form of a common sentence without being encrypted. (*Taniguchi, col. 13, lines 55 – 60*). The display unit (an LCD or CRT) for displaying various information does not perform any encryption or decryption of information, since it is merely sent to the display unencrypted. Moreover, Taniguchi specifically discourages processing and encryption or decoding functions for vehicle mounted apparatus. (*Taniguchi, col. 12, lines 28 – 36*). In so far as the Taniguchi system sends information unencrypted to a display unit, while discouraging encryption and decryption at the vehicle mounted apparatus, Taniguchi does not identically disclose a rights analysis unit, which is coupled to a playback unit, that checks whether a usage right exists to playback the useful data, as provided for in the context of the claimed subject matter.

Claim 1 to 4 and 17 to 18 were rejected under 35 U.S.C. 103(a) as unpatentable over Taniguchi reference. *Paper Number 20080215, p. 4.*

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28

U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (*See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

It is respectfully submitted that obviousness rejections without documentary evidence “should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration.” MPEP § 2144.03(A). The Taniguchi reference does not teach the present mount, place or locate the system, apparatus or device inside the vehicle (such as the dashboard or even in the trunk) as the Office Action essentially admits. *Paper Number 20080215*, p. 6. In accordance with MPEP § 2144.03(C) and 37 CFR § 1.104(d) (2), it is respectfully submitted that an Examiner’s affidavit should be provided to support the obviousness rejections as to the asserted steps (or items) that were present within the art at the time of the presently claimed subject matter.

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, *supra*, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

It is believed and respectfully submitted that the present Office Action offers no evidence, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper

evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that it simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully submitted that Taniguchi, taken separately or in any combination, does not describe or suggest the features of independent claims 1 and 17. Claims 2 to 8, 10 to 14, and 18 depend from claim 1 and 17, respectively, and are therefore also allowable. Accordingly, it is submitted that claims 1 to 4 and 17 to 18 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP

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By Gerard A. Messina

Gerard A. Messina
(Reg. No. 35,952)
One Broadway
New York, New York 10004
(212) 425-7200
Customer No. 26646

By R
legna
33,865
Aaron C
DEPUTY